

Attorney Docket No. CCK94028RE
U.S. Patent Application No.: 10/054,245

#4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

In re Application of

CARDY, et al.

Reissue Application Serial No.: 10/054,245

Filed: January 24, 2002

: Group Art Unit: 2645

: Examiner: Not Assigned

: Confirmation No.: 3727

For: **TELECOMMUNICATIONS SYSTEM HAVING SEPARATE SWITCH
INTELLIGENCE AND SWITCH FABRIC**

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. 1.47(a)

Commissioner for Patents
Box DAC
Washington, D.C. 20231

Sir:

In the Decision Refusing Status under 37 C.F.R. 1.47(a) mailed on July 31, 2002, the U.S. Patent and Trademark Office indicated that the Petition under 37 C.F.R. § 1.47(a) filed January 24, 2002, was dismissed because it lacked (1) proof that the non-signing inventor(s) cannot be reached or refuse to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings). Applicants reply with the following submission to meet the requirements for acceptance of the petition under 37 C.F.R. § 1.47(a).

In another attempt to both locate and have inventors Carol Waller and Ken Rambo execute the Declaration, the undersigned requested in a cover letter sent to Ms. Waller's and Mr. Rambo's last known residence address that they each review enclosed copies of the specification, claims and drawings, and return an executed copy of the Declaration and Assignment.

Attached hereto (Attachment A) is a copy of the letter sent to Carol Waller (dated September 13, 2002). Ms. Waller's last known address is as follows:

302 S. Malone Road
Allen, Texas 95002

On September 15, 2002, the undersigned received a voice message from Ms. Waller indicating receipt of the application and formal documents and a grudging willingness to review the reissue application. On or about September 27, Applicants received a reply letter from Carol Waller (see Attachment B) indicating that, for various reasons, she would be unable to review application and sign the attached declaration. The undersigned's supervisor, Paul Roberts attempted to contact Ms. Waller once again on or about November 22, 2002 in an attempt to resolve any issues and have Ms. Waller sign the declaration (See Attachment C, Mr. Roberts' Affidavit). However, Mr. Roberts has not heard any response from Ms. Waller. Accordingly, the undersigned respectfully submits that sufficient proof has been submitted herewith that Ms. Waller has been presented with the application papers, but is unable or unwilling to sign the declaration.

Attached hereto (see Attachment D) is a copy of the letter sent to Ken Rambo (dated September 27, 2002). Mr. Rambo's last known address is as follows:

454 Garfield Street
Denver, Colorado 80206

On October 31, 2002, the undersigned received a letter from Ken Rambo (see Attachment E) indicating that, based upon his current employment agreement with Qwest Communications Inc., he was unable to accept confidential information from a telecommunications company without a prior executed non-disclosure agreement in place. Mr. Rambo returned the reissue application and formal documents to the

undersigned. The undersigned in a letter dated November 8, 2002 (see Attachment F) represent the necessary application papers and formal documents to Mr. Rambo and explained to him his ongoing obligations to WorldCom, Inc. The undersigned has not received any indication that Mr. Rambo intends to or has signed the declaration provided for a second time in the November 8, 2002 letter. Accordingly, the undersigned respectfully submits that sufficient proof has been submitted herewith that Mr. Rambo has been presented with the application papers, but is unable or unwilling to sign the declaration.

In view of the fact that joint applicants and co-inventors Ken Rambo and Carol Waller have in their possession a copy of the application and Declaration but refuse to sign it, Applicants submit that the requisite proof that the non-signing inventors are unwilling or unable to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings) has been provided.

Accordingly, Applicants respectfully request reconsideration of the of the Petition under 37 CFR 1.47(a). Thus, the granting of the Petition under 37 CFR 1.47(a) is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 CFR 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 13-2491 and please credit any excess fees to such deposit account.

Respectfully submitted,



Brian C. Oakes
Registration No. 41,467

WorldCom, Inc.
1133 19th Street, N.W.
Washington, DC 20036
(202) 736-6371
Date: December 30, 2002
Facsimile: 202-736-6824

Attorney Docket No. CCK94028RE
U.S. Patent Application No.: 10/054,245

ATTACHMENT A

WORLD COM



Law and Public Policy
Technology Law Group
1133 19th Street, NW
Washington, DC 20036

WORLD COM CONFIDENTIAL

brian.oakes@wcom.com

VIA EXPRESS MAIL #EJ096995978US
w/ RETURN RECEIPT REQUEST

September 13, 2002

Carol Waller
302 S. Malone Road
Allen, Texas 95002

Re: Declaration and Power of Attorney for Reissue Patent Application No. 10/054,245
Title: Telecommunications System Having Separate Switch Intelligence
and Switch Fabric
Docket No.: CCK94028RE

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Dear Ms. Waller:

We have previously attempted to obtain your signature on a reissue declaration prior to filing a reissue patent application based upon U.S. Patent No. 6,041,109, entitled "Telecommunications System Having Separate Switch Intelligence and Switch Fabric". The United States Patent and Trademark Office (USPTO) has required us to again attempt to obtain your signature on the reissue declaration since you are named as a co-inventor in the reissue application.

Accordingly, we have enclosed a copy of the patent for the reissue patent application, including the specification, issued claims, and drawings. Additionally, enclosed herewith are the new claims, set forth in a preliminary amendment, that are filed in the reissue application. Please review the entire patent (including the new claims) and sign and date the enclosed reissue Declaration form where your name is listed. So that we may respond to the USPTO in a timely fashion, please promptly complete and return the signed form to us in the addressed postage paid envelope enclosed for your convenience.

If we do not receive the signed Declaration from you by September 27, 2002, we will assume that you are either unable or unwilling to cooperate in further supporting this patent application.

Should you have any questions about any of the above, please contact me directly at the number provided below or call my assistant, Tracy Goodwin, at (202) 736-6090. Thanks in advance for handling this promptly.

Best regards,

Brian C. Oakes
Associate Technology Counsel

WorldCom, Inc.
Technology Law Dept.
1133 19th Street NW
Washington, DC 20036
Tel: (202) 736-6371
Fax: (202) 736-6382

Enclosures

Attorney Docket No. CCK94028RE
U.S. Patent Application No.: 10/054,245

ATTACHMENT B



302 S. Malone Road
Allen, Texas 75002
September 26, 2002

Brian C. Oakes
Associate Technology Counsel
WorldCom, Inc.
1133 19th Street NW
Washington, DC 20036

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JAN 06 2003

OFFICE OF PETITIONS

Dear Sir:

You stated in your letter, dated September 13th, that you had previously attempted to obtain my signature on the revised patent application for US Patent No. 6,041,109. This is not entirely accurate, as I indicated to you in my voice mail message of September 15, 2002.

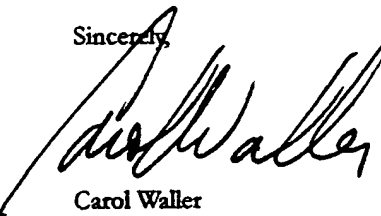
Beginning in October 2001 and continuing through January 2002, I spent a great deal of time and effort involved with various WorldCom representatives working on this patent extension application. However, I had difficulties with some of the proposals, and WorldCom was unwilling to change some of the claims. Therefore, I could not sign my name to the document as I did not support the statements within the claims extensions.

The document that you sent to me for review is the same as the document I could not sign in January 2002. Additionally, I received the document on September 15th and it is due back to you on September 27th. This is not sufficient time for review and changes. I must assume by this that you again are unwilling to make changes to the application. Therefore, I can not sign this reissue patent application as it was presented to me...

It would be more helpful if adequate time were allowed for discussion and edits, as well as ensuring that your statements in the initial letter of September 13th were accurate.

It is not correct to say that I am unwilling or unable to support this patent - I will continue to support the granted patent and I will continue to review and evaluate any reissue applications. But I do not agree with the claims in this reissue and, hence, can not sign this application.

Sincerely,



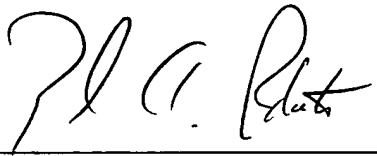
Carol Waller

Attorney Docket No. CCK94028RE
U.S. Patent Application No.: 10/054,245

ATTACHMENT C

5. I have not heard any reply from her at this time and conclude that she does not intend to assist any further in the prosecution of this application.

All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true. I understand that willful false statements and the like are punishable by fine or imprisonment or both (18 U.S.C. 1001) and may jeopardize the validity of this application or any patent issuing therefrom.



Paul Roberts

12/30/02

Date

Attorney Docket No. CCK94028RE
U.S. Patent Application No.: 10/054,245

ATTACHMENT D

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Law and Public Policy
Technology Law Group
1133 19th Street, NW
Washington, DC 20036

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brian.oakes@wcom.com

VIA EXPRESS MAIL #EU003735567US
w/ RETURN RECEIPT REQUEST

September 27, 2002

Ken Rambo
454 Garfield Street
Denver, CO 80206

Re: Declaration and Power of Attorney for Reissue Patent Application No. 10/054,245
Title: Telecommunications System Having Separate Switch Intelligence
and Switch Fabric
Docket No.: CCK94028RE

Dear Mr. Rambo:

We have previously attempted to obtain your signature on a reissue declaration prior to filing a reissue patent application based upon U.S. Patent No. 6,041,109, entitled "Telecommunications System Having Separate Switch Intelligence and Switch Fabric". The United States Patent and Trademark Office (USPTO) has required us to again attempt to obtain your signature on the reissue declaration since you are named as a co-inventor in the reissue application.

Accordingly, we have enclosed a copy of the patent for the reissue patent application, including the specification, issued claims, and drawings. Additionally, enclosed herewith are the new claims, set forth in a preliminary amendment, that are filed in the reissue application. Please review the entire patent (including the new claims) and sign and date the enclosed reissue Declaration form where your name is listed. So that we may respond to the USPTO in a timely fashion, please promptly complete and return the signed forms to us in the addressed postage paid envelope enclosed for your convenience.

If we do not receive the signed Declaration from you by October 11, 2002, we will assume that you are either unable or unwilling to cooperate in further supporting this patent application.

Should you have any questions about any of the above, please contact me directly at the number provided below or call my assistant, Tracy Goodwin, at (202) 736-6090. Thanks in advance for handling this promptly.

Best regards,

Brian C. Oakes

Associate Technology Counsel

WorldCom, Inc.
Technology Law Dept.
1133 19th Street NW
Washington, DC 20036
Tel: (202) 736-6371
Fax: (202) 736-6382

Enclosures

EU 003735567 US

Attorney Docket No. CCK94028RE
U.S. Patent Application No.: 10/054,245

ATTACHMENT E



Ken Rambo
454 Garfield St.
Denver, CO 80206

October 31, 2002

Law and Public Policy
Technology Law Group
1133 19th Street, NW
Washington, DC 20036

Attn: Mr. Brian C. Oakes, Associate Technology Counsel

Re: Declaration and Power of Attorney for Reissue Patent Application No. 10/054,245
Title: Telecommunications System Having Separate Switch Intelligence and Switch
Fabric
Docket No.: CCK94028RE

Dear Mr. Oakes:

Per my current employment agreement with Qwest Communications Inc., I am unable to accept confidential information from a telecommunications company without a prior executed non-disclosure agreement in place between Qwest and the company in question. As such, and per Qwest company policy, I am returning the confidential information to you.

If you feel that there are reasons why I am able and obliged to accept confidential information from your company, please feel free to provide that justification. Otherwise, Qwest company policy will require a signed NDA between the two companies before I can accept this information.

Best regards,

A handwritten signature in black ink, appearing to be "Ken Rambo", written over a horizontal line.

Ken Rambo

Attorney Docket No. CCK94028RE
U.S. Patent Application No.: 10/054,245

ATTACHMENT F

WORLDCOM



Law and Public Policy
Technology Law Group
1133 19th Street, NW
Washington, DC 20036

brian.oakes@wcom.com
Tel: (202) 736-6371

WORLDCOM CONFIDENTIAL

November 8, 2002

VIA FEDEX
Ken Rambo
454 Garfield Street
Denver, CO 80206

Re: Declaration and Power of Attorney for Reissue Patent Application No. 10/054,245
Title: Telecommunications System Having Separate Switch Intelligence
and Switch Fabric

Dear Mr. Rambo:

I am writing in response to your letter of October 31, 2002, and further to our letter of November 1, 2002, as it appears that our correspondence may have crossed in the mail. Your letter states that since there is no non-disclosure agreement (NDA) in place between Qwest Communications Inc. and WorldCom, Inc. ("WorldCom"), that you are unable to accept any confidential information from WorldCom.

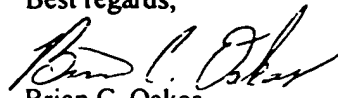
As indicated in our previous correspondence, the assistance we are seeking from you arises from your ongoing personal contractual obligations to WorldCom from the New Products, Ideas, Inventions, and Confidential Data Agreement (the "Agreement") you signed during your employment with MCI Communications, a predecessor of WorldCom. These obligations exist entirely separate and apart from your relationship with Qwest. Under the terms of the Agreement, you are contractually obligated to assist WorldCom in its efforts to perfect its intellectual property rights. Since you are contractually obligated to WorldCom to keep the documents we provide to you confidential, and since we are not seeking any non-disclosure commitments from Qwest in connection with the information we are providing to you, there is no need for an NDA between Qwest and WorldCom.

In view of the above, we are resubmitting to you the entire patent for reissue (including the new claims) and declaration for your review. We again ask that you review the specification and drawings of the patent for reissue, the new claims presented in the reissue application and the reissue declaration. After your review is completed, we again ask that you sign and date the reissue Declaration form where your name is listed.

So that we may respond to the USPTO in a timely fashion, please promptly complete and return the signed form to us in the addressed postage paid envelope also enclosed. Again, I would remind you of your continuing obligation to WorldCom to keep these documents confidential and instruct that you not disclose them to Qwest or any other third party.

If we do not receive the signed Declaration from you by **November 22, 2002**, we will assume that you are either unable or unwilling to cooperate in further supporting this patent application. Should you have any questions about any of the above, please contact me directly at the number provided above.

Best regards,



Brian C. Oakes

Associate Technology Counsel

Enclosures